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BELL, BOYD & LLOYD, LLC
P. O. BOX 1135
CHICAGO, IL 60690-1135

EXAMINER	
FERGUSON, KEITH	

ART UNIT	PAPER NUMBER
2683	7

DATE MAILED: 08/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/914,414	Applicant(s) SCHULZ, EGON	
	Examiner Keith T. Ferguson	Art Unit 2683	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *17 December 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *16-30* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *16-19 and 22-30* is/are rejected.

7)☒ Claim(s) *20 and 21* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 6.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless -
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 16-19,22,23,25 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Losh.

The claimed invention reads on Losh as follows:

Regarding claims 16 and 22, Losh discloses a method (fig. 2) for controlling the selection of base stations in a cellular radio telecommunications system (fig. 2 and description) the method comprising operating, in at least one radio cell of the radio telecommunications system (fig. 1), at least one base station (cell C1-C7)(fig. 1 and col. 2 lines 30-67) and at least one radio device (fig. 1 number 28) are operated for the purposes of wireless telecommunication (col. 2 lines 30-67) supporting at least one first service (frequency 1) (col. 4 lines 39-48) and one second service (frequency 2) (col. 4 lines 39-48), storing connection-relevant data (neighboring scan list of frequencies of the cells) in at least one memory via the radio device (radio network termination) (col. 7 lines 43-45), signaling to the radio device, via at least one base station (col. 6 lines 23-25),in system information (pilots), which service (frequencies) base station supports (col. 6 lines 23-25), storing primary data records (neighboring scan list frequencies) of the base stations in the form of a first list in the memory (col. 7 lines 43-60), if the base stations signal to the radio device in the system

information that they support the first service (col. 7 lines 43-60), storing secondary data records (candidate scan list of frequencies) of the base stations in the form of a second list (col. 7 lines 43-60), if the base stations signal to the radio device in the system information that they support the second service (col. 6 lines 16-35), and updating the first list via the radio device (i.e. neighboring identifiers) if the data of one base station is modified (i.e. base stations added or deleted (col. 5 line 47 through col. 6 line 11).

Regarding claim 17, Losh discloses the data records of the base stations stored or to be stored in the lists are arranged according to transmission characteristics (frequency characteristics) of the base stations (col. 4 lines 39-53 and col. 7 lines 39-60).

Regarding claim 18, Losh discloses the data records of the base stations stored or to be stored in the lists are arranged at least according to an ordering criterion (fig. 5 and fig. 6), the respective ordering criterion being based on the type of data (frequency) stored or to be stored (fig. 5 and fig. 6).

Regarding claim 19, Losh discloses the data records of the base stations stored or to be stored in the lists are arranged in the sequence of their occurrence (fig. 7).

Regarding claim 23, Losh discloses allocating, given a plurality of radio cells (c1-c7) in the radio telecommunications system (fig. 10, the same radio ranges to the radio cells (frequency one for cells c1-c7)(col. 2 lines 59-66).

Regarding claim 25, Losh discloses allocating, given a plurality of radio cells (c1-c6) in the radio telecommunications system (fig.1), different radio ranges to the radio cells (frequency 2 for c1-c6)(col. 2 lines 59-66).

Regarding claim 28, Losh discloses different types of data (carrier frequency) are transmitted in the first service and in the second service (col. 5 lines 7-19 and col. 5 lines 55-65).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 24,26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Losh.

Regarding claims 24 and 26, Losh discloses a method for controlling the selection of base stations in a cellular radio telecommunications system as discussed supra in claims 16,23 and 25 above. Losh differs from claims 24 and 26 of the present invention in that it does not explicit disclose the radio telecommunications system operates according to the DECT standard and UMTS standard. However, DECT standard and UMTS standard are known in the art in cellular and wireless communication. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made for the the radio telecommunications system operates according to the DECT standard and UMTS standard, since it was known in the art that DECT standard and UMTS standard are used in cellular and wireless communication systems.

Regarding claim 27, Losh discloses the same type of data (carrier frequency) is transmitted in the first service and in the second service (col. 5 lines 7-19), and the first service and the second service are made available in different radio cells (col. 5 lines 7-19).

5. Claim 29 is rejected under 35 U.S.C. 103(a) as being unpatentable over Losh in view of Hamalainen et al..

Regarding claim 29, Losh discloses a method for controlling the selection of base stations in a cellular radio telecommunications system as discussed supra in claims 16 and 28 above. Losh differs from claim 29 of the present invention in that it does not disclose signals with the transmission rate of 32kbit/s are transmitted in the first service, and signals with the transmission rate of 64kbit/s are transmitted in the second service. Hamalainen et al. teaches 64kbit/s services for transmission digital data services (paragraph 0004) and 32kbits transmission for mobile video transmission (paragraph 0004). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Losh with signals with the transmission rate of 32kbit/s are transmitted in the first service, and signals with the transmission rate of 64kbit/s are transmitted in the second service in order for the radio device to select a candidate base station from the list with the type of data transmission rate needed for service, as taught by Hamalainen et al..

6. Claim 30 is rejected under 35 U.S.C. 103(a) as being unpatentable over Losh in view of Hamalainen et al. as applied to claim 29 above and in further view of Kristnamurthi et al..

Regarding claim 30, the combination of Losh and Hamalainen et al. differs from claim 30 of the present invention in that they do not disclose voice is transmitted in the first service and packet data are transmitted in the second service. Kristnamurthi et al. teaches a subscriber unit receiving packet service (paragraph 0016) and voice service on a new call (paragraph 0016). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Losh and Hamalainen et al. with voice is transmitted in the first service and packet data are transmitted in the second service in order for the radio device to select the base station within the list according to a voice call or packet data connection for service, as taught by Kristnamurthi et al..

Allowable Subject Matter

7. Claims 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: Regarding claim 20, the prior art of record fails to teach or suggest, alone or in combination reading out a first data record, via the radio device, of the primary data records when the radio device sets up a telecommunications connection to the at least one base station which supports the first service; reading out a first data record, via the radio device, of the secondary data records when the radio device sets up a telecommunications connection to the at least one base station which supports the second service; reading out a second data record, via the radio device and if the connection set up fails, from one of the primary and the secondary data records in the respective lists and setting up a connection to the corresponding at least one base station via the radio device; and restarting the read out of the first data record of the respective list, via the radio device, if no connection has yet been set up and the second data record was the last data record in the respective list.

Regarding claim 21, the prior art of record fails to teach or suggest, alone or in combination reading out a first data record of the primary data records, via the radio device, when the radio device sets up a telecommunications connection to the at least one base station which supports the first service; reading out a first data record of the secondary data records, via the radio device, when the radio device sets up a telecommunications connection to the at least one base station which supports the second service; reading out a second data record from one of the primary and the secondary data records in the respective list, via the radio device and if the connection set up fails, and setting up a connection to the corresponding at least one base station via the radio device; and restarting the read cut of the first data record of the respective list at an

end of a predefined pause time, via the radio device, if no connection has yet been set up and the second data record was the last data record in the respective list.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Keith Ferguson
Art Unit 2683
August 2, 2004